

REMARKS

Reconsideration of the application as amended is respectfully requested.

Please cancel Claims 3 and 17 without prejudice.

Please amend Claims 1, 2 and 5-16 and 18.

Claim 4 is unchanged.

Please accept new Claim 19.

The examiner respectfully rejected Claim 17 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claim 17 has been canceled.

The examiner respectfully rejected Claims 1-3, 5 and 18 under 35 U.S.C. § 102(b) as being anticipated by Jost et al. Claim 3 has been canceled without prejudice. Claims 1, 2, 5 and 18 have been amended and should be in a condition for allowance.

The applicant wishes to further supplement the amendments to Claims 1, 2, 5 and 18 by way of argument.

As to Claim 1, Jost et al. discloses a vocal training device having pressure sensors, a cassette recorder and a playback feature. However, the pressure sensors are not for *detecting* the presence of a subject, but instead is used to *measure* the pressure exerted by the tongue root, the thorax and the flank (Column 1, line 67 through Column 2, line 4). Applicant notes that the amendment to Claim 1 includes the limitation that the sensor is a *presence detecting sensor*, as opposed to the pressure sensor disclosed by Jost et al. Furthermore, Jost et al. does not have a

playback system initiated by the detected presence of a subject, but instead requires manual playback. Finally, Jost et al. does not have a housing which contains both the sensors and the playback initiation system.

As to Claim 2, which has been amended to include the limitation that the system for selecting a prerecorded sound is a selector switch. Jost et al. discloses a system for manually playing back the sounds recorded from the learning session. However, Jost et al. does not disclose a system for selecting sounds recorded or programmed for the apparatus.

As to Claim 5, Jost et al. neither discloses nor claims a *motion* detecting sensor, but instead discloses a *pressure sensor* that detects the pressure exerted by the tongue, thorax and flank of the subject.

As to Claim 18, Jost et al. neither discloses nor claims a device which initiates automatic playback of a prerecorded sound when the presence of a subject is detected. Jost et al. requires manual playback of any recorded sounds.

Based on the above arguments, and the amendments to Claims 1, 2, 5 and 18, the examiner's rejection of Claims 1, 2, 5 and 18 under 35 U.S.C. § 102(b) is inappropriate, and Claims 1, 2, 5 and 18 should be in a condition for allowance.

The examiner respectfully rejected Claims 4 and 6-17 under 35 U.S.C. § 103(a) as being unpatentable over Jost et al. and in view of Easterbrook, and in further view of Jacobson et al. and in further view of Spector. The differences between Jost et al. and the present invention have been stated above.

As to Claim 4, neither Jost et al., Easterbrook, Jacobson et al. nor Spector disclose or suggest the recording of sounds audible to animals. Each of the aforementioned prior art patents are directed at human usage specifically. Thus, there is no suggestion or motivation to incorporate recorded sounds audible to animals.

As to Claims 6-8, the examiner cites Easterbrook in disclosing “pressure sensor, position sensors, velocity sensors and the like.” (Column 3, lines 35-38). The difference between pressure sensors and presence detecting sensors has been stated above. Velocity sensors detect speed and direction, and is obviously different from the presence detecting sensor of the present invention. A position sensor, like a pressure sensor, is dependent upon physical contact with an object or subject to detect angular and spatial arrangements of the object or subject. In Easterbrook, the device is used as a visual training mechanism, specifically related to sports and the instruction of proper athletic mechanics. To measure either proper or faulty mechanics, a position sensor is necessary. In contrast, the present invention employs a presence detecting sensor which does not measure angular and spatial arrangements, but instead is engaged when an object or subject is within a close proximity to the sensor.

As to Claims 9-14, the examiner cites Jost et al. and states that the pressure sensor disclosed might be used as a perch. However, the pressure sensor in Jost et al. is a *belt*. Just because an element is “capable” of such use does not render that element obvious in light of the prior art. The question is not whether the belt could be used as a perch, but whether to do so is obvious in light of the prior art. Arkie Lures, Inc. v Gener Larew Tackle, Inc., 119 F.3d 953, 43

U.S.P.Q. 2d 1994 (Fed. Cir. 1997). There is no suggestion nor motivation that the belt also be used as a perch. Furthermore, there is no indication that the belt is structurally sufficient to be used as a perch. In regard to Claim 14, the support strip (78) of Jacobson et al. is coated with adhesive and is not the bracket disclosed in Claim 14 of the present invention.

As to Claim 15, the examiner cites Spector and states that the disclosed invention teaches a freely standable device. However, Spector discloses and claims a device *installable* in a crib, which requires physically affixing the device to the crib. Furthermore, Spector discloses a pair of hooks for suspending the device from a rail so that the infant might view the device while *lying* down. If the device disclosed in Spector were freely standable within a crib, the infant would be unable to view the device unless it was placed near the head of the infant. Devices directed to infants and cribs incorporate safety as a desirability of the invention. Placing the device near the infant's head would defeat the safety desires of parents.

As to Claims 16 and 17, Claim 17 has been canceled without prejudice. Claim 16 has been amended and incorporates the content and language of Claim 17. As such, Jacobson et al. neither discloses nor claims a device having a trough formed within a bird perch.

Based upon the above arguments, the examiner's rejection of Claims 4 and 6-17, as amended, under 35 U.S.C. § 103(a) is inappropriate.

Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional

argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103(a), the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making an apparatus for teaching a subject to vocally emulate sounds having a presence detecting sensor initiating automatic playback of recorded messages or prerecorded sounds, wherein the device has a mirror and a perch. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837

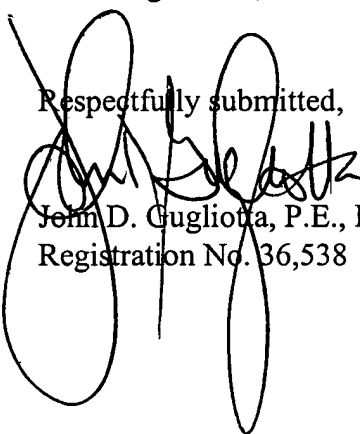
F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention.

However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ 2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and is requested.

Respectfully submitted,

  
John D. Gugliotta, P.E., Esq.  
Registration No. 36,538

The Law Offices of John D. Gugliotta  
202 Delaware Building  
137 South Main Street  
Akron, OH 44308  
(330) 253-5678  
Facsimile (330) 253-6658